

Claims 20, 26 and 27 have been amended to more particularly point out and distinctly claim the subject matter which applicant regards as the invention, while new claims 38-42 have been added to further define aspects of the elected invention as set forth in claims 20, 27, 30, 31. Particularly, claim 20 is now directed to a vehicle manufacturing method involving formation of a protective film on a paint-finished surface using strippable paint ..., and also expressly defines that the strippable paint remains coated on the vehicle during the assembly step of mounting the engine and functional parts to the vehicle. Dependent claims 26, 27 are amended to be consistent with amended claim 20.

Applicant respectfully submits that all of the above amendments are fully supported by the original disclosure.

#### Examiner Inquiries

At the bottom of page 3 and on page 4 of the Office Action, the Examiner has posed several questions for response by the applicant. With regard thereto, please consider the following.

1. The Examiner inquires as to whether it was known in the art, prior to applicant's invention, to apply a strippable paint onto small parts. To the applicant's knowledge, it is "prior art" to the present invention to coat small parts with a strippable paint?

2. The Examiner inquires as to what applicant intended to convey by the statement at page 2 of the specification that "With respect to small parts, a strippable paint has been sprayed on them to form a protective film? See the response to 1.

3. The Examiner requests applicant to state what applicant intends by claim 27.

In response, applicant submits that the claim speaks for itself in terms of scope and content.

Also, it is note that the claim specifically encompasses the second and third embodiments of the invention as described at pages 13-16 of the specification, which each involve preliminary and non-preliminary steps for drying an applied coating of strippable paint.

4. The Examiner inquires as to whether applicant intends for the claims to require that the assembling step be performed while the strippable paint coating remains on the vehicle? Indeed, that is applicant's intent, as now expressly set forth in claim 20.

#### The Rejections

At the bottom of page 2 and the top of page 3 of the Office Action, the Examiner has rejected claims 20 and 26 under 35 USC §102(b) as being anticipated by or, in the alternative, under 35 USC §103(a) as being obvious over Swidler (US Patent 5,281,436). It is the Examiner's position that; although Swidler fails to disclose the claimed step of "assembling the paint-finished automobile by mounting an engine and functional parts thereto" after strippable paint has been applied thereto, Swidler does apply the strippable paint to form a protective film on the automobile and he recognizes that protection of the automobile is required during the assembly process, so that one of ordinary skill in the art would have found it obvious to apply the strippable paint of Swidler prior to and leave it on while performing the assembly process to protect the automobile during same; and the inspection step of claim 26 is obvious since it is conventional in the manufacture of automobiles.

Upon careful consideration applicant respectfully traverses such rejection, and submits that claims 20 and 26 are clearly patentably distinct over the Swidler reference, because Swidler not only fails to disclose the claimed vehicle manufacturing method in which strippable paint is applied to a painted surface of an automobile prior to mounting of an

engine and functional parts to the automobile in an assembly process, or prior to the final inspection after the assembly process, but Swidler teaches away from such method, as understood from his full disclosure.

Swidler generally discloses (at col. 5, lines 8-36 and lines 57-68) a method of applying a substantially continuous film of a strippable paint to a paint finished surface, such as the exterior of an automobile or other vehicle or any item having a sensitive finish exposed to deleterious environmental factors, and he also discloses (at col. 5, lines 37-56) a method of transporting vehicles *subsequent* to an assembly process. Although Swidler generally mentions (at his col. 1, lines 11-14 and lines 39-41) that vehicle finishes are subject to a variety of injuries during the assembly process and that various solutions have been attempted to protect the exposed vehicle surfaces during manufacturing, Swidler's full disclosure of his actual invention has nothing to do with (and hence teaches away from) vehicle manufacturing-assembly.

Rather, Swidler is particularly concerned with "...damage in the first months following manufacture because the paint has not had sufficient time to cure", and especially during transit, while the specific prior example he discusses (at his col. 1, lines 41-46) relates to use of *non-reusable* plastic and vinyl covers which are "...prohibitively expensive for mass shipments or typical driving." Such non-reusable covers are clearly distinct from the *reusable* anti-scratch covers used during the conventional vehicle assembly process, as discussed at pages 20 - 21 of the present specification. Swidler's disclosure and invention addresses nothing more than the conventional, disadvantageous practices occurring *subsequent* to final inspection of an assembled automobile, discussed at page 20, line 10 - page 21, line 17.

Relatedly, Swidler also fails to address or appreciate the advantages which are achieved by the present invention over conventional practices in the art, including the ability to more efficiently apply the strippable paint in terms of space and equipment during vehicle manufacture production via a production line, prevention of scratching, dust adhesion and the like to the paint finished surfaces during later stages of vehicle assembly, and elimination of conventional fitting and removal of anti-scratch covers before and after the assembly step, etc., as discussed at pages 20-26 of the specification. Instead, Swidler's invention is only discussed in terms of preventing damage to paint finished surfaces of the vehicle subsequent to vehicle manufacture-assembly.

In this regard, applicant respectfully traverses the Examiner's allegation that the inspection step of claim 26 is conventional in the manufacture of automobiles because, in fact, the claimed inspection step occurring after the strippable paint has been coated on the vehicle is not conventional, and is not shown to be conventional by any evidence of record.

Based on the foregoing, applicant respectfully submits that the rejection of claims 20 and 26 based on the Swidler reference is overcome, and it is respectfully requested that such rejection be reconsidered and withdrawn.

At page 3 of the Office Action, the Examiner has rejected claims 27, 30-33 and 37 under 35 USC §103(a) as being unpatentable over the Swidler reference. It is the Examiner's position that these claims are properly held to be matters of engineering design choice for the reasons expressed in the Examiner's Answer.

Upon careful consideration applicant respectfully traverses such rejection, and submits that the rejected claims are clearly patentably distinct over the Swidler reference, based on the

deficiencies of Swidler discussed above and because the Examiner has not presented any factual basis necessary under 35 USC §103(a) that the features of these dependent claims are obvious matters of engineering design choice, and that the evidence of record and applicant's disclosure actually contradict the Examiner's position, as discussed at pages 12-13 of applicant's Brief on Appeal and pages 4-5 of applicant's Reply Brief.

In this regard, it is noted that the Courts and the Board of Patent Appeals and Interferences (BPAI) have consistently held that, for purposes of establishing obviousness under 35 USC §103, a rejection advanced by an Examiner must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art, and that the Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. Ex Parte Hamond, 41 USPQ2d 1217, 1220 (BPAI 1996), citing In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Based on the foregoing, applicant respectfully submits that the Examiner has not established prima facie obviousness of the subject matter of any of claims 27, 30-33 and 37 under 35 USC §103(a) based on the Swidler reference, and accordingly it is respectfully requested that the rejection be reconsidered and withdrawn.

At page 3 of the Office Action the Examiner also indicates that "The rejections contained in the Examiner's Answer are hereby repeated and maintained." In the Answer, claims 20, 26 27, 30-33 and 37 all were rejected under 35 USC§103(a) as being unpatentable over applicant's admitted prior art as defined in the specification in view of US Patent 5,428,880 to Tomioka et al.

Applicant again respectfully traverses such rejection for those all of the arguments presented in the Brief on Appeal and the Reply Brief, and again respectfully requests reconsideration and withdrawal of the rejection.

New claims 38-42 are believed to be allowable over the references of record based on the foregoing arguments relating to claims 20, 27, 30 and 31, as well as on the merits of the additional features presented in the new claims.

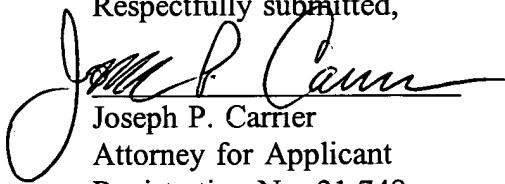
In conclusion, applicant has overcome the Examiner's objections and rejections as presented in the Office Action; and moreover, applicant has considered all of the references of record, and it is respectfully submitted that the invention as defined by each of the present claims is clearly patentably distinct thereover.

The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

Favorable reconsideration is respectfully requested.

A petition for a Three-Month Extension is being submitted herewith.

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to the Box Non-Fee Amendments, Assistant Commissioner for Patents, Washington, DC 20231, on November 17, 1999.

JPC/ms

